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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,290	12/12/2003	Warren Keith Edwards	D/A3420	4296

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EXAMINER	
INGBERG, TODD D	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/736,290	EDWARDS ET AL.	
	Examiner	Art Unit	
	Todd Ingberg	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 November 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/7/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1 – 28 have been examined.

Information Disclosure Statement

1. The Information Disclosure Statement filed June 7, 2004 has been considered.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Legal words like Method and System should be removed.

Drawings

3. The drawings were received on November 1, 2004. These drawings are accepted.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 and 24 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. How to implement a service "***... to offer functionality substantially equivalent to the network service provided by the service host system***" that is substantially equivalent to a undefined service is deemed critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms ***"...to offer functionality substantially equivalent to the network service provided by the service host system***." is indefinite. How to determine what is "substantially equivalent" and what is not is not clear.

7. Claims 2, 3, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "***well-known methods***" is indefinite. How well-known is not clear. Examiner interprets the term to mean built into a language or standard (i.e. JAVA or CORBA etc).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1- 28 are rejected under 35 U.S.C. 102(a) as being anticipated by Schmidt et al. USPN # 6,545,554 B1 issued April 8, 2003 and filed June 21, 2000 (**Auto**).

Claim 1

Auto teaches a system for providing self-installing software components

for network service execution (Auto, Abstract – self install), comprising:

a basic communication framework established with a service host system executing a network service software component to provide a network service (Auto, Abstract, to browser and col 2, lines 33-38); a checking mechanism to determine availability of the network service software component (Auto, col 6, lines 18-32 – JNet Helper checks proxy) and to verify prerequisites against a runtime environment through the service host system
(Auto, Abstract and col 2, lines 13-39 – environment associated with registered browser)
; and a helper mechanism to execute a code bundle providing the network service software component (Auto, Abstract and col 2, lines 13-39 – Helper) through the service host system logically grouped with installation instructions for the network service software component (Auto, JAR File, Abstract and col 2, lines 13 – 39).

Claim 2

A system according to Claim 1, further comprising:
a set of well-known methods provided through a public interface defined on the network service software component (Auto, col 2, lines 22-26 – class path as a set of Universal Resource Identifiers).

Claim 3

A system according to Claim 2, wherein the well-known methods
are selected from the group comprising at least one of an availability method (Auto, col 2, lines 16 – 21), environment verification method (Same as prior – registered browser and metafile), code retrieval method (Auto, col 2, lines 21 – downloaded file), and an update method (Auto, col 2, lines 30-34 – auto install).

Claim 4

A system according to Claim 1, wherein the network service

software component is updated through the service host system (Auto, col 12, lines 33-49 - ISP).

Claim 5

A system according to Claim 1, further comprising:

an installation predicate object defined on the service host system to verify that the runtime environment satisfies prerequisites necessary to install and execute the network service software component. (Auto, col 2, lines 15-24 – environment tied to helper application, registered browser metafile).

Claim 6

A system according to Claim 5, wherein the installation predicate

object is implemented in at least one of mobile code (Auto, col 4, lines 34-52) for execution within a managed code platform (Auto, JAVA – inherently has a Virtual Machine (JVM)) and in platform-specific native code (Auto, col 14, lines 28-57).

Claim 7

A system according to Claim 1, further comprising:

a helper object defined on the service host system to locate and obtain copies of one or more of the network service software components necessary to satisfy one or more of the prerequisites. (Auto, col 2, lines 13 - 39).

Claim 8

A system according to Claim 7, wherein the helper object (Auto, col 2, lines 30-39) is

implemented in at least one of mobile code (Auto, col 4, lines 34-52) for execution within a managed code platform (Auto, JAVA – inherently has a Virtual Machine (JVM)) and in platform-specific native code. (Auto, col 14, lines 28-57).

Claim 9

A system according to Claim 1, further comprising:

an update object defined on the service host system to identify (JNet Help as per claim 1), retrieve and install any updates to the network service software component. (Auto, Abstract – download and install).

Claim 10

A system according to Claim 9, wherein the update object is implemented in at least one of mobile code (Auto, col 4, lines 34-52) for execution within a managed code platform (Auto, JAVA – inherently has a Virtual Machine (JVM)) and in platform-specific native code (Auto, col 14, lines 28-57).

Claim 11

A system according to Claim 1, wherein the network service software component in the code bundle is implemented to offer functionality substantially equivalent to the network service provided by the service host system. (Auto, col 2, lines 13-39 – applets within a browser and col 13 lines 1 - 20).

NOTE: The terms "substantially equivalent" are not given patentable weight.

Claim 12

A system according to Claim 1, wherein the network service software component in the code bundle is implemented to offer functionality differing from the network service provided by the service host system. (Auto, col 11, line 61 to col 12 line 23).

Claim 13

A system according to Claim 1, wherein the basic communication framework comprises a Java operating environment. (Auto, col 17, lines 1 – 5, JAVA platform – the JVM inherent part of Java).

Claim 14

A method for providing self-installing software components for network service execution, comprising:

establishing a basic communication framework with a service host system executing a network service software component to provide a network service;

determining availability of the network service software component and verifying prerequisites against a runtime environment through the service host system; and

executing a code bundle providing the network service software component through the service host system logically grouped with installation instructions for the network service software component. See the rejection for claim 1.

Claim 15

A method according to Claim 14, further comprising:

specifying a set of well-known methods provided through a public interface defined on the network service software component. See the rejection for claim 2.

Claim 16

A method according to Claim 15, further comprising: defining the well-known methods selected from the group comprising at least one of an availability method, environment verification method, code retrieval method, and an update method. See the rejection for claim 3.

Claim 17

A method according to Claim 14, further comprising:

updating the network service software component through the service host

system. See the rejection for claim 4.

Claim 18

A method according to Claim 14, further comprising: defining an installation predicate object on the service host system to verify that the runtime environment satisfies prerequisites necessary to install and execute the network service software component. See the rejection for claim 5.

Claim 19

A method according to Claim 18, wherein the installation predicate object is implemented in at least one of mobile code for execution within a managed code platform and in platform-specific native code. See the rejection for claim 6.

Claim 20

A method according to Claim 14, further comprising: defining a helper object on the service host system to locate and obtain copies of one or more of the network service software components necessary to satisfy one or more of the prerequisites. See the rejection for claim 7.

Claim 21

A method according to Claim 20, wherein the helper object is implemented in at least one of mobile code for execution within a managed code platform and in platform-specific native code.

See the rejection for claim 8.

Claim 22

A method according to Claim 14, further comprising:

defining an update object on the service host system to identify, retrieve and install any updates to the network service software component. See the rejection for claim 9.

Claim 23

A method according to Claim 22, wherein the update object is implemented in at least one of mobile code for execution within a managed code platform and in platform-specific native code. See the rejection for claim 10.

Claim 24

A method according to Claim 14, further comprising: implementing the network service software component in the code bundle to offer functionality substantially equivalent to the network service provided by the service host system. See the rejection for claim 11.

Claim 25

A method according to Claim 14, further comprising: implementing the network service software component in the Code bundle to offer functionality differing from the network service provided by the service host system. See the rejection for claim 12.

Claim 26

A method according to Claim 14, wherein the basic communication framework comprises a Java operating environment. See the rejection for claim 13.

Claim 27

A computer-readable storage medium holding code for performing the method according to Claim 14. (Auto, Figure 1, #34 – Fixed Disk).

Claim 28

An apparatus for providing self-installing software components for network service execution, comprising:

means for establishing a basic communication framework with a service host system executing a network service software component to provide a network service;

means for determining availability of the network service software component and means for verifying prerequisites against a runtime environment through the service host system; and

means for executing a code bundle providing the network service software component through the service host system logically grouped with installation instructions for the network service software component. See the rejection for claim 1.

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis Bullock can be reached on (571) 272-3759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Todd Ingberg/
Primary Examiner

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